

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of)	
)	
Smith et al.)	Art Unit: 3763
)	
Application No. 10/691,968)	Examiner: Stigell, Theodore J.
)	
Filing Date: October 24, 2003)	Confirmation No. 6975
)	
For: METHOD OF TRANSDERMAL)	
DELIVERY OF PERMEANT		
SUBSTANCES		

ELECTION UNDER RESTRICTION REQUIREMENT AND AMENDMENT

MAIL STOP AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA. 22313-1450

NEEDLE & ROSENBERG, P.C.

Customer Number 23859

February 5, 2007

Sir:

In the Action dated January 25, 2007, the Examiner has restricted the application and has required an election of one of two groups set forth on page 2 of the Action. The application has been restricted into the following two groups:

Group I - Claims 1-40 and 76-79, as drawn to methods of delivering permeant substances, classified in class 604, subclass 500; and

Group II - Claims 41-75 and 80-81, as drawn to methods of evaluating the effectiveness of a microporator, classified in class 600, subclass 309.

Applicants provisionally elect Group I with traverse and, accordingly, in the event no generic claim is held to be allowable, provisionally elect Claims 1-40 and 76-79. Applicants acknowledge that, upon allowance of a generic claim, Applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 C.F.R. 1.141.

For a restriction requirement to be proper, the Examiner must satisfy the following two criteria: (1) the existence of independent and distinct inventions (35 U.S.C. § 121); and (2) that the search and examination of the entire application cannot be made without *serious burden* on the Examiner. *See* M.P.E.P. § 803. Applicants request that the restriction requirement be reconsidered because the Examiner has not met the burden of demonstrating that a *serious burden* would be required to examine all the claims. M.P.E.P. § 803 provides:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions. (*Emphasis added.*)

Applicants respectfully submit that the Examiner has not shown that the second requirement has been met. Specifically, there has been no showing that it would be a serious burden to search and examine the two groups together. The species are related in that they involve permeant delivery via formed micropores. Because little or no additional burden would be required to search and examine the groups together, Applicants respectfully submit that the Examiner should search and examine the groups together. Indeed it would be most efficient to keep them together.

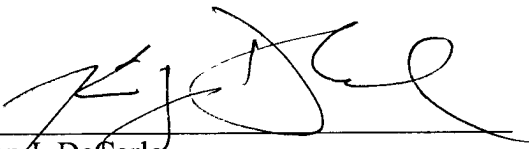
Consequently, reconsideration and modification or withdrawal of the restriction requirement is requested. For the reasons stated above, Applicants respectfully assert that restriction of the claims as set forth by the Examiner would be contrary to promoting efficiency, economy and expediency in the Patent Office and further point out that restriction by the Examiner is discretionary (M.P.E.P. § 803.01). Thus, Applicants respectfully request that all of the claims of this application be examined together. Consequently, reconsideration and modification or withdrawal of the restriction requirement is requested.

Applicants await an action on the merits.

No fees are believed to be due, however, the Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 14-0629.

Respectfully submitted,

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